

REMARKS / ARGUMENTS

The present application includes pending claims 1-41, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1, 3-6, 8, 10-12, 15, 16, 21-23, 25-30, 32-35, 38 and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2004/0204031, issued to Kardach, et al. (hereinafter, Kardach). Claims 2, 13, 14, 19, 24, 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kardach, in view of U.S. Patent No. 6,978,121, issued to Lane, et al. (hereinafter, Lane). Claims 7, 17, 29 and 40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kardach, in view of U.S. Patent Publication No. 2004/0218580, issued to Bahl, et al. (hereinafter, Bahl). Claims 9 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kardach, in view of U.S. Patent Publication No. 2004/0009751, issued to Michaelis, et al. (hereinafter, Michaelis). Claims 18 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kardach, in view of U.S. Patent No. 7,003,285, issued to Carter (hereinafter, Carter). Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kardach, in view of Lane as applied to claim 19 above, and further in view of Michaelis. The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

I. The Final Office Action's Response to Arguments

A. Response to Applicant's Arguments Regarding Claims 1 and 11

The Final Office Action states the following:

In response to the applicant's argument regarding claims 1 & 11 that "Kardach does not disclose or suggest at least the limitations of assigning first and second priority indications to first and second wireless transceiver circuits, respectively, where each priority indication may be selected from a plurality of available priority indications" (Pages 19-24 [A]), the examiner disagrees.

Kardach teaches multiple priority indications for the first (i.e. 802.11) and second (i.e. Bluetooth) wireless transceiver circuits. *Kardach teaches when the first wireless transceiver circuit is transmitting; the second wireless transceiver circuit has three different priorities:*

- a. 1st priority, transmits immediately (Fig. 8 [880])
- b. 2nd priority, transmits after a delay (Fig. 8 [872])
- c. 3rd priority, foregoes transmitting (Fig. 8 [874])

Since giving the second wireless transceiver circuit three distinct priorities inherently gives the 1st wireless transceiver circuit three corresponding priorities to match, therefore Kardach teaches assigning first and second priority indications to first and second wireless transceiver circuits, respectively, where each priority indication may be selected from a plurality of available priority indications.

See the Final Office Action at page 14 (emphasis added). The Applicant respectfully disagrees with the above reasoning and points out that the relevant claim limitation relates to "assigning **first and second** priority

indications to first and second wireless transceiver circuits, respectively."

The Examiner is relying for support on Figure 8 of Kardach. However, the Applicant points out that **steps 872, 874, and 880 described in Figure 8 of Kardach disclose various functions executed by the device 110 on the basis of the single priority level value assigned to the Bluetooth transceiver 220.**

Referring to Figure 8 of Kardach, at 860, the device 110 of Kardach determines whether the 802.11b transceiver system 210 has priority, **based on the single priority level value assigned to the Bluetooth transceiver 220.** If no priority, then Bluetooth signal is transmitted at 880. If there is priority, at 870, the electronic device 110 determines, **still based on the single priority level value assigned to the Bluetooth transceiver 220,** whether or not to delay the Bluetooth communication. See Kardach, Figure 8 and paragraph 0030.

In this regard, communication priority between the Bluetooth transceiver system 220 and the 802.11b transceiver system 210 is based only on a single priority level **and Kardach does not disclose or suggest assigning a first priority level to the first transceiver 210 and assigning a second priority level for the second transceiver 220,** as recited by the Applicant in claim 1.

B. Response to Applicant's Arguments Regarding "Inherency"

The Final Office Action states the following:

In response to the applicant's argument regarding claim 1 and "inherently" (Page 22-23), the examiner disagrees.

The evidence relied upon for the examiner's inherent reasoning can be found in the cited Fig. 8 since the description of Fig. 8 is "flowchart illustrating the operation of the electronic device of Fig. 2", which clearly shows a processor and memory that controls the first and second wireless transceiver circuits. The examiner is using the "inherently" reasoning that a person of ordinary skill in the art would recognize that a **program is running in the memory, being executed by the processor and then assigns one of the three previously stated priorities to the data to be transmitted.** (Fig. 8) The priority assigned is dependent upon the programs that are being executed by the processor. Therefore, the inherently reasoning stands upon clarification.

See Final Office Action at pages 14-15 (emphasis added). **The Examiner is referred to Section I-A above, where the Applicant has illustrated that there is absolutely no support in Kardach that "a program is running in the memory, being executed by the processor and then assigns one of the three previously stated priorities to the data to be transmitted," as asserted by the Examiner.**

The Applicant maintains that the Final Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 1 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a "basis in fact and/or technical reasoning." Accordingly, the Applicant respectfully

maintains that, absent a “basis in fact and/or technical reasoning” for the rejection of record, that rejection should be reconsidered and withdrawn.

REJECTION UNDER 35 U.S.C. § 102

II. Kardach Does Not Anticipate Claims 1, 3-6, 8, 10-12, 15, 16, 21-23, 25-30, 32-35, 38 and 39

The Applicant first turns to the rejection of claims 1, 3-6, 8, 10-12, 15, 16, 21-23, 25-30, 32-35, 38 and 39 under 35 U.S.C. 102(e) as being anticipated by Kardach. With regard to the anticipation rejections under 102(e), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

A. Rejection of Independent Claim 1 under 35 U.S.C. § 102(e)

With regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Kardach does not disclose or suggest at least the limitation of “assigning **first and second priority indications** to first and second wireless transceiver circuits, respectively, where each priority indication may be selected

from a plurality of available priority indications," as recited by the Applicant in independent claim 1 (emphasis added).

The Final Office Action states the following:

Regarding claim 1, Kardach teaches an integrated circuit wireless communication device (Fig. 2 [110]) having at least two wireless transceiver circuits (Fig. 2 [210 & 220]), a method for coordinating potentially conflicting wireless communications, comprising:

assigning first and second priority indications to first and second wireless transceiver circuits, respectively, where each priority indication may be selected from a plurality of available priority indications; (Page 3 [0019 & 0023] and Page 4 [0024]).

See the Final Office Action at page 2. Referring to Figures 1 and 2 of Kardach, the Applicant points out that scheduling communication between the Bluetooth transceiver system 220 and the 802.11b transceiver system 210 is achieved based on an 802.11b operating signal that comprises a **single priority level value**. For example, Kardach discloses the following:

The Bluetooth transceiver 220 may receive an 802.11b operating signal from the 802.11b transceiver system via the communication link 230. The 802.11b operating signal may include channel information indicative of the DSSS channel such as, but not limited to, a reference corresponding to a radio channel for communication associated with the 802.11b transceiver system 210 (e.g., a DSSS channel), an operating mode of the DSSS channel (e.g., active or inactive), and a priority level of communication associated with the 802.11b transceiver system 210 (e.g., low or high) via the DSSS channel.

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See Kardach at paragraph 0019. Furthermore, Kardach discloses the following with regard to the single priority level value communicated to the Bluetooth transceiver 220 via the 802.11b signal from the 802.11b transceiver 210:

The priority level indicates whether the communication associated with the 802.11b transceiver system 210 via the DSSS channel has higher priority over the communication associated with the Bluetooth transceiver system 220 via the FHSS channel.

See *id.* In this regard, communication priority between the Bluetooth transceiver system 220 and the 802.11b transceiver system 210 is based only on a single priority level and Kardach does not disclose or suggest assigning a first priority level to the first transceiver 210 and assigning a second priority level for the second transceiver 220, as recited by the Applicant in claim 1.

Furthermore with regard to the rejection of independent claim 1 under 102(e), the Applicant submits that Kardach does not disclose or suggest at least the limitation of "detecting an application that is configured to receive or transmit data on the second wireless transceiver circuit ... and assigning a third priority indication to the second wireless transceiver circuit when the predetermined application is detected," as recited by the Applicant in independent claim 1 (emphasis added).

The Final Office Action states the following in support:

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inherently detecting a predetermined application that configured to receive or transmit data on the second wireless transceiver circuit; (Pages 4-5 [0029-0031] and Fig. 8)

assigning a third priority indication to the second wireless transceiver circuit when the predetermined application is detected; (Fig. 8 [872, 874 & 880])

See the Final Office Action at page 3. Initially, the Applicant notes that it appears that claim 1 is being rejected, at least partially, based on inherency. That is, the Final Office Action cites that detecting an application on the second wireless transceiver circuit is *inherent*. The Applicant submits that a rejection based on inherency must include a statement of the rationale or evidence tending to show inherency. See Manual of Patent Examining Procedure at § 2112. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” See *id. citing* *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence “must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. **Inherency, however, may not be established by probabilities or possibilities.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The Applicants respectfully submit that neither Kardach itself nor the Final Office

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Action “make[s] clear that the missing descriptive matter,” said to be inherent “is necessarily present in” **Kardach**.

A rejection based on inherency must be based on factual or technical reasoning:

In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Applicant respectfully submits that the Final Office Action does not contain a basis in fact and/or technical reasoning to support the rejection based on inherency. Instead, as recited above, at least claim 1 of the present application stands rejected based on a conclusory statement of inherency, rather than upon a “basis in fact and/or technical reasoning.” Accordingly, the Applicant respectfully submits that, absent a “basis in fact and/or technical reasoning” for the rejection of record, that rejection should be reconsidered and withdrawn.

Furthermore, the Applicant points out that **Kardach**, including paragraphs 0029-0031 and Figure 8, **does not disclose or suggest detecting an application and assigning a third priority indication to the second wireless transceiver when the application is detected**, as claimed by the Applicant in claim 1.

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Accordingly, independent claim 1 is not anticipated by Kardach and is allowable. Independent claims 11, 19, 21, and 33 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11, 19, 21, and 33 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

B. Rejection of Dependent Claims 3-6, 8, 10, 12, 15 and 16

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1 and 11 under 35 U.S.C. § 102(e) as being anticipated by Kardach has been overcome and requests that the rejection be withdrawn. Additionally, claims 3-6, 8, 10, 12, 15 and 16 depend from independent claims 1 and 11, and are, consequently, also respectfully submitted to be allowable.

Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1, 3-6, 8, 10-12, and 15-16.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

III. The Proposed Combination of Kardach and Lane Does Not Render Claims 2, 13, 14 and 19 Unpatentable

The Applicant now turns to the rejection of claims 2, 13, 14 and 19 as being unpatentable over Kardach in view of Lane.

A. The Proposed Combination Does Not Render Claim 19 Unpatentable

With regard to the rejection of independent claim 19 under 103(a), the Applicant submits that the combination of Kardach and Lane does not disclose or suggest at least the limitation of "first means for sending or receiving a first wireless signal having **a first allocated priority**, comprising a first MAC layer module; and second means for sending or receiving a second wireless signal having **a second allocated priority**, comprising a second MAC layer module," as recited by the Applicant in independent claim 19 (emphasis added).

The Final Office Action states:

Regarding claim 19, Kardach teaches an apparatus for implement a dynamic collaboration protocol, comprising:

first means for sending or receiving a first wireless signal having a first allocated priority; (Fig. 2 [210] and Page 3 [0019])

second means for sending or receiving a second wireless signal having a second allocated priority; (Fig. 2 [220] and Page 3 [0019])

See the Final Office Action at page 8. Referring to Figures 1 and 2 of Kardach, the Applicant points out that scheduling communication between the Bluetooth transceiver system 220 and the 802.11b transceiver system 210 is achieved based on an 802.11b operating signal that comprises a **single priority level value**. For example, Kardach discloses the following:

The Bluetooth transceiver 220 may receive an 802.11b operating signal from the 802.11b transceiver system via the communication link 230. The 802.11b operating signal may include channel information indicative of the DSSS channel such as, but not limited to, a reference corresponding to a radio channel for communication associated with the 802.11b transceiver system 210 (e.g., a DSSS channel), an operating mode of the DSSS channel (e.g., active or inactive), and a priority level of communication associated with the 802.11b transceiver system 210 (e.g., low or high) via the DSSS channel.

See Kardach at paragraph 0019. Furthermore, Kardach discloses the following with regard to the single priority level value communicated to the Bluetooth transceiver 220 via the 802.11b signal from the 802.11b transceiver 210:

The priority level indicates whether the communication associated with the 802.11b transceiver system 210 via the DSSS channel has higher priority over the communication associated with the Bluetooth transceiver system 220 via the FHSS channel.

See *id.* In this regard, communication priority between the Bluetooth transceiver system 220 and the 802.11b transceiver system 210 is based only on

a single priority level and the combination of Kardach and Lane does not disclose or suggest receiving a first wireless signal having a first allocated priority and receiving a second wireless signal having a second allocated priority, as disclosed by the Applicant in claim 19.

Accordingly, the proposed combination of Kardach and Lane does not render independent claim 19 unpatentable, and a *prima facie* case of obviousness has not been established. The Applicant submits that claim 19 is allowable.

B. Rejection of Dependent Claims 2, 13 and 14

Claims 2, 13 and 14 depend from independent claims 1 and 11, respectively, and are, consequently, also respectfully submitted to be allowable. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2, 13 and 14.

IV. The Proposed Combination of Kardach and Bahl Does Not Render Claims 7 and 17 Unpatentable

Claims 7 and 17 depend from independent claims 1 and 11, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 7 and 17.

V. The Proposed Combination of Kardach and Michaelis Does Not Render Claim 9 Unpatentable

Claim 9 depends from independent claim 1, and is, consequently, also respectfully submitted to be allowable at least for the reasons stated above. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 9.

VI. The Proposed Combination of Kardach and Carter Does Not Render Claim 18 Unpatentable

Claim 18 depends from independent claim 11, and is, consequently, also respectfully submitted to be allowable. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 18.

VII. The Proposed Combination of Kardach and Lane Does Not Render Claim 20 Unpatentable

Claim 20 depends from independent claim 19, and is, consequently, also respectfully submitted to be allowable. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claim 20.

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CONCLUSION

Based on at least the foregoing, the Applicant believes that all claims 1-41 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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Date: 07-MAY-2007

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